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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,643	06/16/2005	Gerd Steiner	BASF.10039 (PF 54175)	2925
45473	7590	07/12/2006	EXAMINER	
HUTCHISON LAW GROUP PLLC PO BOX 31686 RALEIGH, NC 27612			PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/539,643	<b>Applicant(s)</b> STEINER ET AL.	
	<b>Examiner</b> Alton N. Pryor	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 28 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☐ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 10 and 11 is/are allowed.
- 6) ☐ Claim(s) 12-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

- I. Rejection of claims 10 and 11 under 35 USC 112, 1<sup>st</sup> paragraph will not be maintained in light of amendment filed 4/28/06 for reason as follows. Applicant has replace "alkinyl" by "alknlyl". Applicant refers to USPN 6960580 will discloses that the terms are interchangeable.
- II. Rejection of claims 12,17 under 35 USC 112, 2<sup>nd</sup> paragraph will not be maintained in light of amendment filed 4/28/06 for reason as follows. The term "aromatic group" has been deleted from the claims.
- III. Rejection of claims 13,18 under 35 USC 112, 2<sup>nd</sup> paragraph will not be maintained in light of amendment filed 4/28/06 for reason as follows. The term "aromatic group" has been deleted from the claims. Applicant explains that antecedent basis is provided for the functional groups.

Applicant's arguments filed 4/28/06 have been fully considered but they are not persuasive. See arguments below.

- IV. Rejection of claims 12-14,17-19 under 35 USC 103(a) as being obvious over Howell et al (US 3444169) will be maintained in light of amendment filed 4/28/06 for reason on record and reason as follows.

Applicant argues: Howell 1) disclose tranquilizers instead of pesticides and that the tranquilizer in Howell would not be expected to act as pesticides of the instant claims; 2) does not provide motivation to select the claimed species. Examiner argues that in a claim to a compound / composition a statement of intended use has no patentable significance. In addition, Examiner argues that Howell does

Art Unit: 1616

provide ample motivation to make the compounds of the instant claims since Howell teaches the core and suggests the substituents to be attached to the core through Markush language. See 103(a) rejection 1/31/06.

V. Rejection of claims 12,13,15,17,18,20 under 35 USC 103(a) as being obvious over Schmutz et al (US 3539573) and claims 16,21 under 35 USC 103(a) as being obvious over Schmutz et al (US 3389139) will be maintained in light of amendment filed 4/28/06 for reason on record and reason as follows.

1) Schmutz discloses analgesics, antihistamines, etc. (pharmaceuticals) instead of pesticides and that the analgesics, antihistamines (pharmaceuticals) in Schmutz would not be expected to act as pesticides of the instant claims; 2) Schmutz discloses preferred compounds where substituents are in the 3 or 8 position rather than in both positions as instantly claimed. For this reason Schmutz does not provide motivation to select the claimed species. Examiner argues that in a claim to a compound / composition a statement of intended use has no patentable significance. In addition, Examiner argues that Schmutz does provide ample motivation to make the compounds of the instant claims since Schmutz suggests the compounds through Markush language. Note preferred compounds in a reference does not disclosed all compounds suggested by the reference. A reference is not required to exemplify all possible examples to be relied upon as prior art.

VI. Allowable Subject Matter

Art Unit: 1616

Claims 10 and 11 are allowable. The prior art does not teach or suggest a method of using instant compounds as a pesticide.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

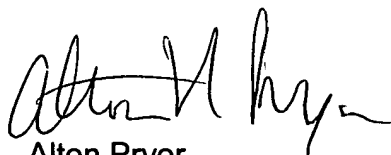
***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Alton Pryor', is positioned above the printed name.

Alton Pryor  
Primary Examiner  
AU 1616